Atty. Docket No. MP0267 (13298/11)
PATENT APPLICATION

Application No. 10/678,523
Response dated July 19, 2007
Office Action mail date: April 19, 2007

REMARKS/ARGUMENTS

Claims 7, 11-14, 19, 20, 22-25, 29-37, 39-42, 46-53, 70, 74-77, and 82 are being examined on the merits in the present application. The remainder of claims 1-96 are withdrawn from consideration pursuant to Applicant's Response to the Examiner's Restriction Requirement/Election of Species.

Responsive to the Examiner's objection to the specification, Applicants respectfully point out that the provisional applications listed there are identified correctly. No updating is believed necessary. If the Examiner has a particular point to raise in this regard, the Examiner is respectfully requested to so indicate in the next communication.

The Examiner has rejected claim 20, 22-25, 29-37, 39-42, 46-53, 70, 74-77, and 82 under 35 U.S.C. § 112, second paragraph. The Examiner also has rejected all of the pending claims under 35 U.S.C. § 101. The Examiner has rejected claims 7, 11, 13, 20, 22, 29-31, 33, 36-37, 39, 46-48, 50, 53, 70, 74, and 76 under 35 U.S.C. § 102(a) as anticipated by USP 6,477,552 (Ott '552). The Examiner also has rejected claims 19, 23-24, 35, 40-41, 52, and 82 under 35 U.S.C. § 103(a) as unpatentable over Ott in view of USP 6,697,828 (Ott '828). Applicant respectfully traverses all of these rejections, and requests reconsideration and allowance of the claims in view of the following arguments.

Turning first to the §112, second paragraph, rejection, Applicant respectfully submits that there is nothing unclear about claim 20. Claim 20 recites an apparatus for performing the method according to claim 7. The Examiner states, "It is unclear whether the claim is an apparatus for a method since the claim cites an apparatus for performing a method". The Examiner's own quote indicates that the claim clearly states what it is about. Claim 7 is a

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method claim; claim 20 recites an apparatus for performing that method. As the Examiner

knows, method claims are not, by their terms, limited to being performed by a particular

apparatus. That an apparatus is recited for performing that method indicates a particular

apparatus for performing that claimed method. There is nothing indefinite about the apparatus

limitations recited in this claim. And there is nothing in the claim that would prevent an

ordinarily skilled artisan from understanding what is being claimed, and what would or would

not infringe the claim. Therefore, Applicant submits that claim 20 is not indefinite and

respectfully requests that the Examiner reconsider and withdraw this rejection.

The same reasoning applies to claim 37. Therefore, Applicant submits that claim 37

likewise is not indefinite, and requests that the Examiner reconsider and withdraw this rejection

as well.

Applicant similarly requests that the Examiner withdraw the rejection of claims

dependent 22-25, 29-36, 39-42, and 46-53 on this basis.

Claim 70 is simply a software claim containing language which has been approved by the

Court of Appeals for the Federal Circuit in *In re Beauregard*. A software claim does not have to

recite particular instructions for performing a method. As the Examiner knows, "program code"

contains at least program instructions. Program code that performs a method necessarily

includes program instructions for performing that method. Therefore, Applicant submits that

claim 70 and claims 74-77 and 82 are not indefinite. Accordingly, Applicant respectfully

requests that the Examiner reconsider and withdraw this rejection as well.

Turning now to the § 101 rejection, finding a free bit in a register necessarily involves

interacting with a hardware apparatus to find a bit. Clearly there is something physical, concrete,

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or tangible entailed in all of these elected claims. There need not be any claimed specific purpose which would be accomplished as a result of finding that next free bit. Clearly, and merely by way of example, a purpose for finding a next free bit in a register is to find a place in a register to put a bit. Applicant need not recite that purpose specifically in the claim for the ordinarily skilled artisan to be able to discern that that would be a clearly useful purpose for the claimed invention.

Because one or more useful purposes for the claimed invention clearly are discernible from the claims, Applicant submits that all of the pending claims in the pending application recite statutory subject matter under 35 U.S.C. § 101, and accordingly Applicant requests that the Examiner reconsider and withdraw this rejection.

Finally, turning to the prior art rejections, Applicant respectfully submits that there is nothing whatsoever in either of the Ott references that teaches or even remotely suggests the identification of a next free bit in a register for any purpose. Assuming for the sake of argument that there are arithmetic operations disclosed in Ott which bear some similarity to one or more of the arithmetic operations disclosed in the present application, nothing in either Ott reference suggests in any way that those arithmetic operations either are for the purpose of, or necessarily inherently result in, finding a next free bit in a register. None of the portions of either Ott reference which the Examiner has cited – including portions which show arithmetic operations – disclose or suggest anything whatsoever about finding a free bit in a register. Instead, these references relate to detecting leading zeroes in a number, which the Ott references call an operand. *See*, *e.g.*, Ott '552 1:33-36; Ott '828 1:46-48. The operands are 32-bits in length, and

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are divided into four-bit "nibbles". *See, e.g.*, Ott '552 2:36-40; Ott '828 1:48-50. None of this relates to finding the next free bit in a register.

The Examiner has failed to cite any particular portion of Ott '552 which specifically describes finding a next free bit in a register. Breaking a check sector into parts does not identify a free bit in a register. The Ott '552 Abstract reference to a zero bit within a nibble is not an identification of a free bit in a register. Selecting a leading zero part does not identify a free bit in a register.

Likewise, assuming *arguendo* that Ott '828 somehow describes creating a check sector (even though the reference does not use that language), Ott '828 nowhere describes or suggests finding a next free bit in a register.

Pursuant to the foregoing, Applicant submits that the elected claims are patentable over the Ott references, taken alone or in combination, and accordingly Applicant submits that the Examiner reconsider and withdraw these rejections as well.

Request for Allowance

It is believed that this Amendment places the application in condition for allowance, and early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

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The Office is hereby authorized to charge any fees, or credit any overpayments, to

Deposit Account No. **11-0600**.

Respectfully submitted,
KENYON & KENYON LLP

Dated: July 19, 2007   By: /Frank L. Bernstein/
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